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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,857	03/10/2004	Matthew A. Fordham	00,1247-A	3724

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EXAMINER	
KIM, PAUL	

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/797,857	FORDHAM, MATTHEW A.	
	Examiner	Art Unit	
	Paul Kim	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 14-25* is/are rejected.

7)☒ Claim(s) *6-13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/12/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is responsive to the following communication: Divisional application filed on 10 March 2004.

2. Claims 1-25 are pending and present for examination. Claims 1, 14, 19 and 23 are independent.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 12 December 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Priority

4. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/918,838, filed on 31 July 2001. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of

the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

This application appears to be a division of Application No. 09/918,838, filed on 31 July 2001. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known

as a divisional application or "division." The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 14-18 and 19-22 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 6 respectively of prior U.S. Patent No. 6,714,934. This is a double patenting rejection.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 1 and 2-13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward "a method for creating a vertical search engine" and are non-statutory because they do not encompass tangible subject matter and/or embodiments which fall within a statutory category.

The claims make no mention of a tangible medium wherein existing code may be processed to perform the recited steps in the claims. See State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106. "The claimed invention as a whole must accomplish a practical application. That is, it must produce a 'useful, concrete and tangible result' " (emphasis added).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. **Claims 1, 2, 4 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis (U.S. Patent No. 6,490,575, hereinafter referred to as BERSTIS), filed on 6 December 1999, and issued on 3 December 2002, in view of Brady et al (U.S. Patent No. 6,463,430, hereinafter referred to as BRADY), filed on 10 July 2000, and issued on 8 October 2002.

11. **As per independent claims 1 and 23**, BERSTIS, in combination with BRADY, discloses:

A method for creating a vertical search engine, comprising:

receiving a list of a plurality of keywords to be used for the vertical search engine on a network device {See BRADY, C2:L17-39, wherein this reads over "Vertical Portals"}, wherein the list of keywords includes general and specific keywords for a selected subject {See BERSTIS, C10:L49-52, wherein this reads over "lists of keywords may be periodically updated automatically"};

processing the list of plurality of keywords to create a refined list of keywords, wherein the processing includes adding, subtracting or modifying automatically the list of plurality of keywords {See BERSTIS, C10:L49-52, wherein this reads over "lists of keywords may be periodically updated automatically"};

creating a plurality of first index files associated with a plurality of first data files by checking a plurality of domain names from a plurality of domain name files associated with a domain name system for a computer network {See BERSTIS, C8:L52-55, wherein this reads over "such resultant data includes the identity and network addresses of network sites containing one or more of the searched keywords"; and C9:L4-7, wherein this reads over "each of local sites have an

associated local database which maintains a list of keywords compiled from within each site"},

wherein the plurality of first index files include a plurality of pointers to the associated data files {See BERSTIS, C9:L12-16, wherein this reads over "local indices include processing means for indexing the current keyword lists such that each of the keywords is associated with one or more of the multiple Web pages within each respective site; and C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"}, and

wherein the plurality of first data files include a plurality of entries including electronic information extracted from a plurality of web-sites associated with a plurality of active domain names from the plurality of domain name files {See BERSTIS, C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"};

creating a plurality of second index files with associated plurality of second data files by searching the plurality of first index files for keywords from the refined list of keywords {See BERSTIS, C4:L57-61, wherein this reads over "[a] global, top-level search engine maintains and periodically updates its own master index; and C10:L49-52, wherein this reads over "lists of keywords may be periodically updated automatically"},

wherein the plurality of second index files include a plurality of pointers to the associated plurality of second data files {See BERSTIS, C9:L12-16, wherein this reads over "local indices include processing means for indexing the current keyword lists such that each of the keywords is associated with one or more of the multiple Web pages within each respective site; and C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"}, and

wherein the plurality of second data files include a plurality of entries including electronic information extracted from a plurality of web-sites associated with the plurality of active domain names for keywords from the refined list of keywords {See BERSTIS, C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"};

verifying that entries in the plurality of second index files are appropriate for the selected subject;

creating a final index from the plurality of entries first index {See BERSTIS, C4:L57-59, wherein this reads over "[a] global, top-level search engine maintains and periodically updates its own master index"}, and

making a vortal accessible on another network device via the computer network for the selected subject using the final index.

It would have been obvious to one of ordinary skill in the art at the time the invention was created to verify that the entries in the second index files fall within the selected subject for the vortal. Additionally, it would have been obvious to one of ordinary skill in the art at the time

the invention was created to have the vortal available for access by another network device via a general computer network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions suggested by BERSTIS and BRADY.

One of ordinary skill in the art would have been motivated to do this modification so that in creating a vertical search engine, keywords are processed to be included in a final index such that the final index correlates to a specific subject or topic.

12. **As per dependent claim 2**, BERSTIS, in combination with BRADY, discloses:

> The method of Claim 1 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method {See BERSTIS, C11:L23-26, wherein this reads over "implementations as a computer system programmed to execute the method or methods described herein, and as a program product"}.

13. **As per dependent claim 4**, BERSTIS, in combination with BRADY, discloses:

> The method of Claim 1 wherein the plurality of entries including electronic information extracted from a plurality of web-sites associated with a plurality of active domain names from the plurality of domain name files include a title, description, a uniform resource locator, or a pre-determined amount of electronic content associated with a web-site associated with an active domain name {See BERSTIS, C4:L62-65, wherein this reads over "the global search engine would retrieve only the Internet Protocol (IP) address of the local sites associated with word-to-page links relating to the searched words"}.

14. **Claims 3, 24 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over BERSTIS, in view of BRADY, and in further view of Official Notice.

BERTIS and BRADY teach the limitations of claims 1, 2, 4 and 23 for the reasons stated above.

BER TIS and BRADY differ from the claimed invention in that they fail to specifically disclose that the DNS for the Internet is included in the DNS for the network (claims 3 and 25).

BERTIS and BRADY differ from the claimed invention in that they fail to specifically disclose that the opening of a .COM, .EDU, .GOV, .MIL, .NET or .ORG top-level domain name file (claim 24).

15. **As per dependent claims 3 and 25**, it would have been obvious to one of ordinary skill in the art at the time the invention was claimed to include the Domain Names System (or "DNS") for the Internet in the DNS for the network.

16. **As per dependent claim 24**, it would have been obvious to one of ordinary skill in the art at the time the invention was claimed to hat the name files associated with a DNS would include opening a .COM, .EDU, .GOV, .MIL, .NET or .ORG top-level domain name file associated with the DNS of the Internet.

17. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over BERSTIS, in view of BRADY, and in further view Sullivan et al (U.S. Patent No. 5,956,711, hereinafter referred to as SULLIVAN), filed on 16 January 1997, and issued on 21 September 1999.

BERTIS and BRADY teach the limitations of claims 1, 2, 4 and 23 for the reasons stated above.

BER TIS and BRADY differ from the claimed invention in that they fail to specifically disclose the method of eliminating generic keywords and adding synonyms and modified spellings of keywords to the list (claim 5).

18. **As per dependent claim 5**, BRADY, in combination with BERSTIS and SULLIVAN, discloses:

The method of Claim 1 wherein the processing step includes:

eliminating keywords that are too generic or have multiple meanings {See SULLIVAN, C4:L4-7, wherein this reads over "[a] restricted keyword list is accessed by the keyword translator which compares the user-entered input with a restricted list of acceptable keywords and acceptable synonyms"};

modifying keywords by adding alternative spellings or additional words {See SULLIVAN, C6:L1-5, wherein this reads over "even one spelling of the same word (e.g., "color" in the United States, v. "colour" in the United Kingdom)"}; and

adding automatically synonyms for keywords to the list of plurality of keywords to create the refined list of keywords {See SULLIVAN, C4:L7-10, wherein this reads over "[i]f the input is not on the list, but it is a synonym for a keyword on the list, then the keyword is substituted before storing the information"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions suggested by BERSTIS, BRADY and SULLIVAN.

One of ordinary skill in the art would have been motivated to do this modification so that certain keywords are added or deleted according to their generic nature or similarity.

Allowable Subject Matter

19. **Claims 6-13** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737.. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chase can be reached on (571) 272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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